

BS01377

U.S. Application No. 10/0202,770 Art Unit 3622
Response to November 21, 2005 Office Action

REMARKS

In response to the Office Action dated November 21, 2005, the Assignee respectfully requests reconsideration based on the above amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

Claims 1, 3-10, 12-18, and 20 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,848,397 to Marsh *et al.* Claims 2, 11, and 19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Marsh. The Assignee shows, however, that the pending claims distinguish over the cited documents.

Rejection of Claims under § 102

Claims 1, 3-10, 12-18, and 20 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,848,397 to Marsh *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the pending claims patentably distinguish over Marsh. The patent to Marsh *et al.* does not disclose all the features of the pending claims, so the Assignee respectfully requests that Examiner Van Bramer remove the 35 U.S.C. § 102 (b) rejection.

The pending claims are not anticipated. All the pending claims recite features not disclosed or suggested by Marsh. Claim 1, for example, recites "*categorizing the advertisement as at least one of an overrideable advertisement and a non-overrideable advertisement, wherein the overrideable advertisement is replaceable with another advertisement, and wherein the non-overrideable advertisement is not replaceable and will be delivered as scheduled.*" Examiner Van Bramer is correct — Marsh prioritizes advertisements so that high priority advertisements

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are presented before lower priority advertisements. *See, e.g.*, U.S. Patent 5,848,397 to Marsh *et al.* (Dec. 8, 1998) at column 3, lines 31-33, at column 3, lines 57-65, and at column 8, lines 47-53. Yet nowhere does *Marsh* describe “overrideable” and “non-overrideable” advertisements. *Marsh*, then, cannot anticipate claim 1.

Marsh also fails to anticipate other claim features. Claim 1 also recites “*receiving a request from an advertiser to replace any overrideable advertisement with another advertisement.*” No where does *Marsh* describe such features. Examiner Van Bramer points to column 9, line 65 through column 10, line 20 of *Marsh*. These passages of *Marsh* discuss sorting the same priority advertisements so that “mutually exclusive” advertisements are separated. As *Marsh* explains, the “advertisement display scheduler may advantageously facilitate separation of particular advertisements.” *Id.* at column 9, lines 65-66. An advertisement, for example, may be associated with other advertisements which are mutually exclusive. *Id.* at column 9, line 67 through column 10, line 3. In such cases conflicting advertisements are eliminated from the sorted queue. *Id.* at column 10, lines 3-7. *Marsh*, then, only discusses separating “mutually exclusive” advertisements — *Marsh* fails to teach or suggest “*receiving a request from an advertiser to replace any overrideable advertisement with another advertisement.*” The evidence, then, does not support the Examiner’s assertion. *Marsh*, then, cannot anticipate claim 1.

Because *Marsh* fails to disclose at least these features, claim 1 is not anticipated. Accordingly, reconsideration and withdrawal of the § 102 rejection is respectfully requested.

Independent claims 9 and 17 are likewise not anticipated. These independent claims recite similar features as claim 1, so independent claims 9 and 17 are not anticipated. Reconsideration and withdrawal of the § 102 rejection of claims 9 and 17 is respectfully requested.

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The dependent claims are not anticipated. The dependent claims incorporate the same distinguishing features, so reconsideration and withdrawal of the § 102 rejection of the dependent claims is respectfully requested.

Rejection of Claims under 35 U.S.C. § 103 (a)

Claims 2, 11, and 19 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Marsh*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows above, however, because *Marsh* fails to disclose many features recited in the pending claims, *Marsh* cannot obviate the pending claims. Claims 2, 11, and 19 depend on their respective base claims and, thus, incorporate the same distinguishing features. Claims 2, 11, and 19, for example, include "*categorizing the advertisement as at least one of an overrideable advertisement and a non-overrideable advertisement, wherein the overrideable advertisement is replaceable with another advertisement, and wherein the non-overrideable advertisement is not replaceable and will be delivered as scheduled.*" Claims 2, 11, and 19 also incorporate "*receiving a request from an advertiser to replace any overrideable advertisement with another advertisement.*" Because *Marsh* fails to teach or suggest at least these features, one of ordinary skill in the art would not find the claims obvious over *Marsh*. Accordingly, reconsideration and withdrawal of the § 103 rejection is respectfully requested.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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